

REMARKS

Claims 17, 18, 20-23, 28-31 and 34-52 are pending in the above-identified application.

Issues regarding Priority Document

The Office Action dated June 3, 2009 indicates that a certified translation of the Priority Document (i.e. DE 197 01 446.1) has not yet been submitted. However, such a certified translation of the Priority Document was already submitted in the parent Application No. 09/748,006 (now US Patent No. 7,232,792) on July 12, 2005. Therefore, it is requested that the Examiner obtain this document from the electronic file of the parent '792 patent. It is also noted that some priority data is absent from the parent '792 patent despite the fact that the originally filed documents, including a copy of the originally filed Declaration signed by the inventors, provided a correct claim to priority and clearly identified all priority information. Applicant will proceed to submit a Certificate of Correction to complete the priority information for the parent '792 patent.

Election and Restriction Requirements

The Examiner has required election in the present application between:

Group I -- claims 18, 20, 21, 28-31, and 35-52 directed to products; and

Group II -- claims 17, 22 and 23 directed to processes.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 18, 20, 21, 28-31, and 35-52. It is respectfully requested that the Examiner withdraw the Requirement. Regarding claim 17, it is submitted that the recited process results in a product defined in one of the elected claims of Group I, such that re-joinder should be considered. Regarding claims 22 and 23, it is submitted that there is not undue burden placed on the Examiner to substantively examine these claims which essentially depend for patentability on the structural features of the compounds of formula I as recited in elected claims from Group I.

The Office Action correctly identifies Applicant's elected species as the compound recited in claim 30, and correctly lists the claims at the bottom of page 7 that read on the elected species. This Election Requirement is respectfully traversed as it is submitted all the presently

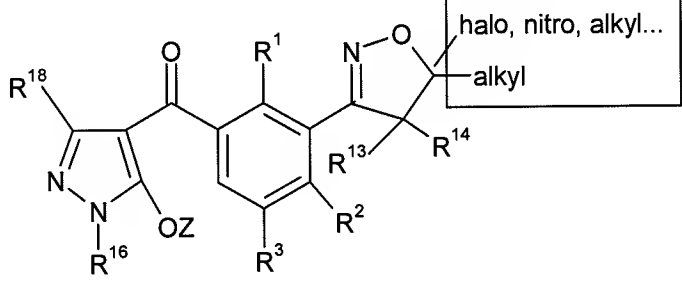
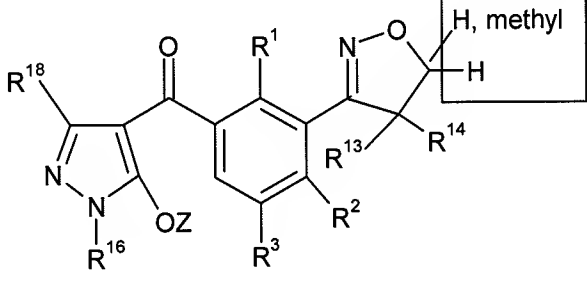
claimed compounds share a core structure which does not create an undue burden on the Examiner to substantively examine all of the claimed subject matter. Thus, it is requested that the Election Requirement also be withdrawn.

Double Patenting Rejections

Co-Pending Application No. 11/739,928

Claim 30 has been rejected based on double patenting in view of claim 8 of Co-Pending Application No. 11/739,928. Claim 30 has also been provisionally rejected under 35 USC 101 as allegedly claiming the same invention as claims 7-9 of Co-Pending Application 11/739,928.

The above rejections should be withdrawn. First, claim 8 has been cancelled from Application 11/739,928 by the filing of an Amendment under 37 CFR 1.312 on July 26, 2009. Second, a review of claims 7 and 9 in Application 11/739,928 indicates that these claims both depend from claim 3 therein which does not allow for R⁴ and R⁵ to both be hydrogen. Below is a comparison between present generic claim 28 (encompassing claim 30) and the compounds claimed in Application 11/739,928.

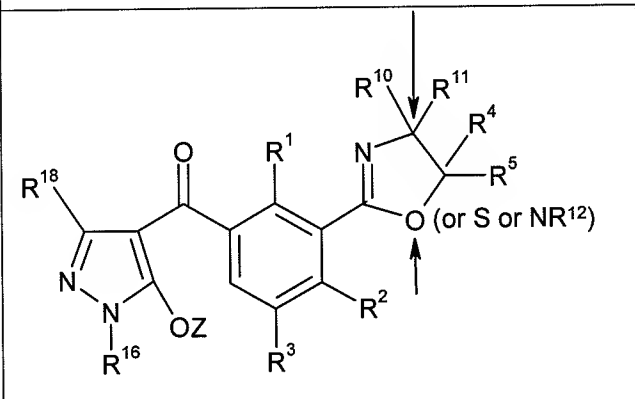
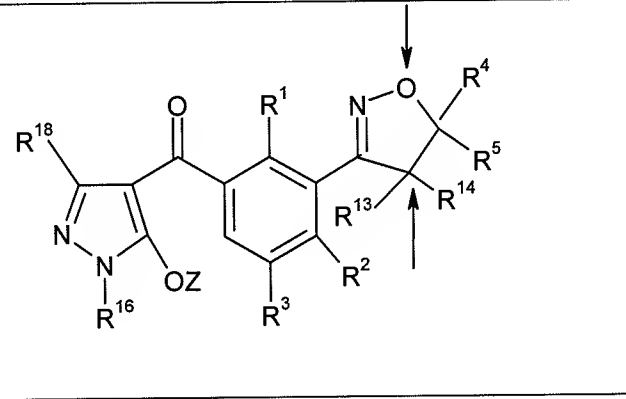
US 11/739,928	present application (generic claim 28)
	

In view of the above absence of an overlap, it is submitted that the rejection under 35 USC 101 should be withdrawn.

US Patent No. 7,232,792

Claims 21, 28-30, 35-37, 47, 48, 50 and 51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of US Patent No. 7,232,792.

Regarding the claims of US 7,232,792 (the "child" application), the following structural distinctions exist:

US 7,232,792 (child-application)	present application
	

Both X and Y are defined differently in US 7,232,792 and the present application. As the positions of X and Y are not interchangeable, a completely different heterocycle is defined and consequently, there is no overlap between the structures. Thus, it is requested that this double patenting rejection be withdrawn.

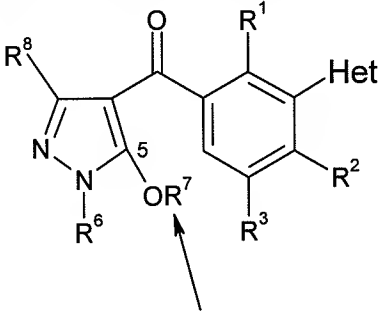
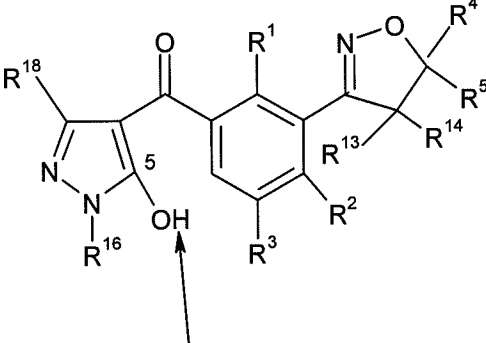
US Patent No. 6,613,719

Claims 21, 28-30, 35-37, 47, 48, 50 and 51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 7 of US Patent No. 6,613,719. Enclosed is a Terminal Disclaimer to remove this rejection.

US Patent No. 6,165,944

Claims 21, 28-30, 35-37, 47, 48, 50 and 51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11, 13 and 16-28 of US Patent No. 6,165,944.

Structural distinctions exist between the compounds claimed in US Patent No. 6,165,944 and the compounds of the present application as shown below.

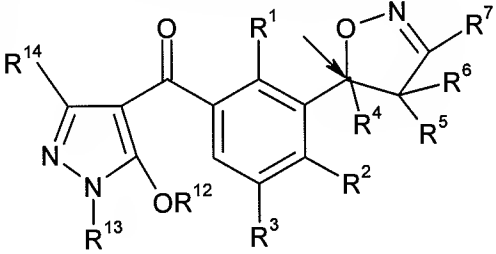
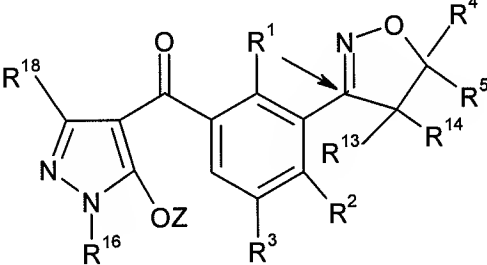
US 6,165,944 (von Deyn et al.)	present application
 <p>The structure shows a pyrazole ring with substituents R⁸ and R⁶. At position 5, there is an OR⁷ group, indicated by an arrow. The pyrazole is linked via a carbonyl group to a benzene ring with substituents R¹, R², and R³. A 'Het' group is also attached to the benzene ring.</p>	 <p>The structure shows a pyrazole ring with substituents R¹⁸ and R¹⁶. At position 5, there is an OH group, indicated by an arrow. The pyrazole is linked via a carbonyl group to a benzene ring with substituents R¹, R², and R³. A 1,3,4-oxadiazole ring is attached to the benzene ring, with substituents R⁴, R⁵, R¹³, and R¹⁴.</p>

The compounds according to the present application are characterized by an OH-radical in 5-position of the pyrazole-ring. The respective position in the compounds according to US 6,165,944 is characterized by C-bound-radicals R⁷, which are linked via oxygen. Consequently, there is no overlap in the chemical structures. Thus, this double patenting rejection should be withdrawn.

US Patent No. 7,151,075

Claims 21, 28-30, 35-37, 47, 48, 50, 51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 10 of US Patent No. 7,151,075.

The compounds claimed in US Patent No. 7,151,075 differ structurally from the claimed compounds of the present application as shown below.

US 7,151,075 (Baumann et al. et al.)	present application
 <p>The structure shows a pyrazole ring with substituents R¹⁴ and R¹³. At position 5, there is an OR¹² group. The pyrazole is linked via a carbonyl group to a benzene ring with substituents R¹, R², and R³. A 1,3,4-oxadiazole ring is attached to the benzene ring, with substituents R⁴, R⁵, R⁶, and R⁷. An arrow points to the C-bound radical R⁷.</p>	 <p>The structure shows a pyrazole ring with substituents R¹⁸ and R¹⁶. At position 5, there is an OZ group. The pyrazole is linked via a carbonyl group to a benzene ring with substituents R¹, R², and R³. A 1,3,4-oxadiazole ring is attached to the benzene ring, with substituents R⁴, R⁵, R¹³, and R¹⁴. An arrow points to the N-bound radical R¹³.</p>

Compounds according to the present application are benzoyl-pyrazoles, which are substituted by 3-isoxazolines, while compounds according to US 7,151,075 are characterized by 5-isoxazolines. Consequently, there is no overlap in the structural formulae. Thus, this double patenting rejection should be withdrawn.

US Patent No. 6,506,708

Claims 21, 28-30, 35-37, 47, 48, 50 and 51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 8 of US Patent No. 6,506,708. Enclosed is a Terminal Disclaimer to remove this rejection.

Co-Pending Application No. 11/739,928

Claims 21, 28-30, 35-37, 47, 48, 50 and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-4, 7-15 and 23-24 of copending Application No. 11/739,928. Enclosed is a Terminal Disclaimer to remove this rejection.

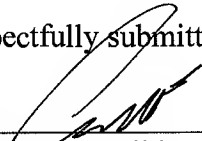
It is submitted for the reasons above that the present claims should be placed into allowable form.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: September 3, 2009

Respectfully submitted,

By 

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Enclosure: Terminal Disclaimers over:

- (1) US Patent No. 6,613,719
- (2) US Patent No. 6,506,708
- (3) US Application Serial No. 11/739,928